REMARKS

Applicant graciously acknowledges the telephone interviews with the Examiner on July 25 and 28, 2005. With this paper, Applicant has attempted to address the issues raised in the interviews. Applicant has studied the Office Action dated May 11, 2005 and the Advisory Action dated September 30, 2005, and has made amendments to the claims. Claims 3, 5, 7-10, 12, 13, 16, 18, 38 and 39 are pending. Claims 3, 5, 7 and 16 are independent claims. Claims 4, 6, 17 and 19-37 have been canceled without prejudice. Claims 3, 5, 7-9, 16 and 18 have been amended. New claims 38-39 have been added. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Claim Amendments

The amendments to claims 7-9 are intended to correct typographical errors and are not related to patentability.

§ 112 Rejections

The Examiner rejected claims 19-22 and 24-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner made the following assertions:

The step "receiving the signals classified by kinds and classifying them again by kinds" in claim 19 is unclear as it is not understood as written.

Claims 24 and 30 cannot be understood and examined as written.

Claims 25-29 and 31-34 are rejected as dependent on, respectively, claims 24 and 30.

With this paper, claims 19-22 and 24-34 have been cancelled without prejudice. It is respectfully submitted that the rejection is, therefore, moot and it is respectfully requested that the rejection be withdrawn.

§ 102 Rejections

Claims 3, 5, 7, 10, 14-16 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Yi (U.S. Patent No. 5,978,365). This rejection is respectfully traversed.

In the telephone interview conducted on July 25, 2005, it was respectfully noted that the Examiner indicated the allowance of claims 7 and 10 and that claims 14 and 15 had been canceled without prejudice by the response to the prior Office Action. It was also respectfully noted that the Examiner did not provide any reason for the rejection of claims 19, although there was a rejection of claim 19 under 35 U.S.C. §103(a) and the Examiner did provide his reasons for that rejection. The examiner apparently argued that the rejection of claims 7, 10, 14, 15 and 19 was the result of a typographical error and it was respectfully requested that the rejection be withdrawn with respect to these claims.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

With regard to the rejection of independent claims 3, 5 and 16, it is respectfully noted that claims 3 and 5 have been amended to recite the initial offset value of the first rate matching algorithm processing unit is different from the initial offset value of the second rate matching algorithm processing unit and claim 16 has been amended to recite rate matching is performed with different initial offset values. It is respectfully submitted that Yi fails to disclose these limitations and the Examiner apparently agrees, as evidenced at paragraph 9 of the Office action, where the Examiner states, "Yi does not teach matching algorithm with different initial offset values".

Since the amended limitation was previously part of canceled claims 4 and 6, which were rejected under 35 U.S.C § 103(a) in paragraph 9 of the Office action in view of TSG-RAN recommendation (TSG-RAN Working group 1 (Radio) meeting #8, 12-15 October 1999, 3GPP) (hereinafter referred to as "TSG-RAN"), the allowability of claims 3, 5 and 16 will also be discussed with respect to claims 4 and 6 and the TSG-RAN reference.

The Examiner indicates, at paragraph 9 of the Office action, that "Yi does not teach matching algorithm with different initial offset values" and asserts that TSG-RAN "teaches different initial offset values (introduction)." The Examiner further asserts, at paragraph 12 of the Office Action, that TSG-RAN "teaches different initial offsets for unlink and downlink." Moreover, the Examiner asserted during the interview on July 28, 2005 that the use of the parameter "N" in the formulas for the uplink and downlink offset in section 2 of TSG-RAN is sufficient to teach using "different initial offset values" since "N" would not necessarily be the same for the "first and second rate matching algorithm processing units" recited in claims 4 and 6. Applicant respectfully disagrees with the Examiner's interpretation of TSG-RAN.

As was respectfully noted in the response to the prior Office Action and in the telephone interview with the Examiner on July 28, 2005, TSG-RAN discloses, in the introduction, "the initial offset value ... should be replaced as proposed." As was further respectfully noted in the response to the prior Office Action and in the telephone interview with the Examiner on July 28, 2005, TSG-RAN is directed to "show[ing] the effects of changing the initial offset to '1'." Moreover, as was respectfully noted in the telephone interview, section 2 of TSG-RAN discloses "1 for proposed initial offset in the downlink" and "N for current initial offset in the downlink."

As was respectfully submitted in the response to the prior Office Action and in the telephone interview with the Examiner on July 28, 2005 teaching to "replace" the initial offset value is not the same as teaching the use of "different initial offset values," as asserted by the Examiner. It is further respectfully submitted that, given that the introduction of TSG-RAN discloses that the initial offset value should be **replaced** as **proposed**, one of ordinary skill in the art would have interpreted TSG-RAN to teach replacing the current value of "N" with the value "1" for the initial offset value in the downlink rather than interpreting TSG-RAN as teaching an additional initial offset value that is "different" from the current offset as required by the Examiner's interpretation. Therefore, it is respectfully asserted that it would **not** "have been obvious to one of ordinary skill in the art at the time the invention was made to add matching algorithm with different initial offset values ... to the system of Yi" as the Examiner asserts and, therefore, the requisite motivation to alter the Yi invention as asserted by the Examiner has not been shown.

It is respectfully submitted that the Examiner is asserting that the use of "different initial offset values" is inherent in the teachings of TSG-RAN. Applicant agrees that inherency is a

legally viable method for interpreting a reference. Verdegaal Bros., Inc. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). However, the "examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

To serve as an anticipation when the reference is silent about the asserted herein characteristic, such a gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill.

Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (emphasis supplied). It is well settled that,

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Continental Can, 20 USPQ2d at 1749 (emphasis original), quoting In re Oerich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)).

Review of TSG-RAN leads to the inescapable conclusion that there is no reasonable basis to believe that TSG-RAN inherently discloses use of "different initial offset values." It is respectfully submitted that nowhere in TSG-RAN is it specifically taught to use "different initial offset values" nor is any single or multiple rate matching algorithm processing unit disclosed. In fact, there is no disclosure at all regarding the value of the parameter "N" nor how "N" is determined. It is respectfully submitted that, in the absence any teaching of multiple rate matching algorithm processing units or the value or process for determining "N" or additional evidence provided by the Examiner, the Examiner's interpretation of TSG-RAN is mere conjecture and that an equally plausible interpretation of the reference is that it teaches using the **same** value, whether that value be "N" or "1," for each of multiple rate matching algorithm processing units in an apparatus.

Therefore, it is respectfully asserted that the limitation of claims 4 and 6 that was incorporated into independent claims 3, 5 and 16 is allowable subject matter that is not taught by either the Yi or TSG-RAN references. It is further respectfully asserted that independent claims

3, 5 and 16 are allowable over the references. In the Advisory Action, the Examiner apparently agreed that the amendments to claims 3, 5 and 16 place them in condition for allowance.

§ 103 Rejections

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yi. This rejection is respectfully traversed.

It is respectfully noted that claim 19 has been cancelled without prejudice with this paper. Therefore, it is respectfully submitted that the rejection is moot and it is respectfully requested that the rejection be withdrawn.

Claims 4, 6, 17, 18, 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yi in view of TSG-RAN. This rejection is respectfully traversed.

It is respectfully noted that claims 17, 36 and 37 have been canceled without prejudice with this paper. Therefore, it is respectfully submitted that the rejection is moot with respect to claims 17, 36 and 37 and it is respectfully requested that the rejection be withdrawn.

The allowability of the subject matter of claims 4 and 6 was discussed with respect to the 35 U.S.C. 102(e) rejection of claims 3, 5 and 16. It is respectfully noted that, with this paper, claims 4 and 6 have been canceled without prejudice and, therefore, the rejection is moot with respect to those claims. It is respectfully requested that the rejection be withdrawn with respect to claims 4 and 6.

With regard to claim 18, which has been amended to more clearly disclose the invention, it is respectfully noted that independent claim 16, upon which claim 18 depends, has been has been amended to incorporate the allowable subject matter from claims 4 and 6 as previously indicated. Therefore, it is respectfully asserted that claim 18 also is allowable over the cited references.

Allowable Subject Matter

Applicant graciously acknowledges the Examiner's allowance of claims 7-13 and 35 and the indication of allowable subject matter in claim 23 in the Office Action. Applicant also graciously acknowledges the Examiner's indication of the allowability of amended claims 3, 5 and 16 in the Advisory Action.

New Claims

With this paper, new claims 38-39 have been added. It is respectfully submitted that no new matter has been added as support for new claims is found in the application as originally submitted. It is further respectfully submitted that claims 38 and 39, which depend from, respectively, claims 3 and 5, are in condition for allowance for the reasons put forth herein with regard to claims 3 and 5.

CONCLUSION

In light of the above remarks, Applicant submits that claims 3, 5, 7-10, 12, 13, 16, 18, 38 and 39 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

Date: October 11, 2005

By: _____

Richard C. Safelder
Registration No. 51,127
Attorney for Applicant(s)

Customer No. 035884

801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211